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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

FEB 14 2002

OIPE/JCWS

In re Patent Application of

Emine CAPAN, et al.

Serial No.: 09/936,891

Filed: September 17, 2001

Date: December 21, 2001

Group Art Unit: - -

Examiner: - -

For: CATALYTIC PROCESS FOR THE MODIFICATION OF CARBOHYDRATES,
ALCOHOLS, ALDEHYDES OR POLYHYDROXY COMPOUNDS

Asst. Commissioner for Patents

Box PCT

Washington, D.C. 20231

COPY OF PAPERS
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RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS
UNDER 35 U.S.C. 371 IN THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)

Sir:

In response to the Notification of Missing Requirements under 35 U.S.C. § 371 in the United States Designated/Elected Office (DO/EO/US), mailed October 24, 2001, we have previously submitted the Inventors' Declaration (copy enclosed) and paid the required fees on October 19, 2001 as evidenced by the attached copy of a postcard stamped by the U.S. Patent and Trademark Office.

In the event the actual fee is greater than the payment submitted or is inadvertently not enclosed or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge the underpayment to Deposit Account #15-0700.

If this communication is filed after the time period had elapsed and no separate Petition is enclosed, the Commissioner of Patents and Trademarks is petitioned, under 37 C.F.R. § 1.136(a), to extend the time for filing a response by the number of months which will avoid abandonment under 37 C.F.R. § 1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 15-0700.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Asst. Commissioner for Patents, Box PCT, Washington, D.C. 20231, on December 21, 2001

Edward A. Meilman

Name of applicant, assignee or
Registered Representative

Edward A. Meilman
Signature

December 21, 2001

Date of Signature

Respectfully submitted,

Edward A. Meilman
Edward A. Meilman
Registration No.: 24,735
OSTROLENK, FABER, GERB & SOFFEN
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700

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<input checked="" type="checkbox"/> Commissioner For Patents, Box PCT, United States Patent and Trademark Office, Washington, D.C. 20231, www.uspto.gov		
<div style="border: 2px solid black; padding: 5px; display: inline-block;"> RECEIVED OCT 31 2001 </div>		
U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.

09/936,891

Emine Capan

P/2107-181

INTERNATIONAL APPLICATION NO.

PCT/EP00/02351

I.A. FILING DATE

PRIORITY DATE

03/16/2000

03/16/1999

Edward A. Meilman
 Ostrolenk Faber Gerb & Soffen
 1180 Avenue of the Americas
 New York, NY 10036-8403

OFGS FILE No.	P/2107-181
24 DEC 2001 EAM	
PATENT OFFICE	

CONFIRMATION NO. 2941

371 FORMALITIES LETTER



OC00000006947636

Date Mailed: 10/24/2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Priority Document
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Information Disclosure Statements
- Oath or Declaration
- Preliminary Amendments
- Request for Immediate Examination

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 TC 1700

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
 - is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
- \$130 Surcharge for providing the oath or declaration later than the appropriate 30 months from the priority date (37 CFR 1.492(e)) is required.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$130** for a Large Entity:

- **\$130** Late oath or declaration Surcharge.

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

WINSTON M ALVARADO

Telephone: (703) 305-6421

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/936,891	PCT/EP00/02351	P/2107-181

Serial No. 09/936 891 Filing Date 9/21/01 OFCS Ff. No. P/2107-181
Title Catalytic Process For The Modification of
First Inventor Emine CAPAN, et al. Date 10/19/01
The PTO has received: Last Due Date: _____

- ☐ Patent Application of _____
Pages (including claims & abstract)
☒ Declaration or ☐ Designation Sheet
☐ Drawings _____ Sheet(s)/Figs. _____ to _____
☐ Priority Document
☐ Small Entity Declaration
☒ Assignment & Conveyance Cover Sheet
☐ Information Disclosure Statement
☐ PTO-1449
☐ Amendment
☐ Affidavit or Declaration

- ☐ TM Application ☐ ITU Basis
☐ Statement of Use
☐ Extension of Time
☐ Notice of Ap
☐ Brief
☐ Petition
☐ Status Request
☐ Issue Fee
☒ Certificate of Mailing
☒ Express Mail No. EL 075473401US

PTO STAMP

☒ PCT 2nd Submission
☒ Check No. 06947 for \$ 170.00
Atty/Secy EAM:SS

JC18 Rec'd PCT/PTO 19 OCT 2001

TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)
CONCERNING A FILING UNDER 35 U.S.C. 371

P/2107-181

U.S. APPLICATION NO. (If known, see 37 CFR 1.5)

09/936,891

INTERNATIONAL APPLICATION NO.

PCT/EP00/02351

INTERNATIONAL FILING DATE

16 March 2000

PRIORITY DATE CLAIMED

16 March 1999

TITLE OF INVENTION CATALYTIC PROCESS FOR THE MODIFICATION OF CARBOHY-
DRATES, ALCOHOLS, ALDEHYDES OR POLYHYDROXY COMPOUNDS

APPLICANT(S) FOR DO/EO/US

Emine CAPAN et al.

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☐ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☒ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☐ This is an express request to promptly begin national examination procedures (35 U.S.C. 371(f)).
4. ☐ The US has been elected by the expiration of 19 months from the priority date (PCT Article 31).
5. ☐ A copy of the International Application as filed (35 U.S.C. 371(c)(2))
 - a. ☐ is attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ has been communicated by the International Bureau.
 - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☐ An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).
7. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))
 - a. ☐ are attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ have been communicated by the International Bureau.
 - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☐ have not been made and will not be made.
8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. ☒ An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).
10. ☐ An English language translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

Items 11 to 16 below concern document(s) or information included:

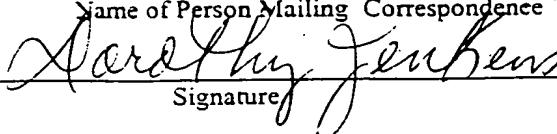
11. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. ☒ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☐ A **FIRST** preliminary amendment.
☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
14. ☐ A substitute specification.
15. ☐ A change of power of attorney and/or address letter.
16. ☐ Other items or information:

EXPRESS MAIL CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail Post Office to Addressee (mail label EL075473401US in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231, on October 19, 2001.

Dorothy Jenkins

Name of Person Mailing Correspondence



Signature

October 19, 2001

Date of Signature

CALCULATIONS PTO USE ONLY

21. ☒ The following fees are submitted:**BASIC NATIONAL FEE (37 CFR 1.492 (a) (1) - (5)):**

Neither international preliminary examination fee (37 CFR 1.482)
nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO
and International Search Report not prepared by the EPO or JPO..... \$1040.00

International preliminary examination fee (37 CFR 1.482) not paid to
USPTO but International Search Report prepared by the EPO or JPO \$890.00

International preliminary examination fee (37 CFR 1.482) not paid to USPTO
but international search fee (37 CFR 1.445(a)(2)) paid to USPTO \$740.00

International preliminary examination fee (37 CFR 1.482) paid to USPTO
but all claims did not satisfy provisions of PCT Article 33(1)-(4) \$710.00

International preliminary examination fee (37 CFR 1.482) paid to USPTO
and all claims satisfied provisions of PCT Article 33(1)-(4) \$100.00

ENTER APPROPRIATE BASIC FEE AMOUNT =

\$

Surcharge of \$130.00 for furnishing the oath or declaration later than ☐ 20 ☐ 30
months from the earliest claimed priority date (37 CFR 1.492(e)).

\$

130.00

CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE	\$
Total claims	- 20 =		x \$18.00	\$
Independent claims	- 3 =		x \$84.00	\$
MULTIPLE DEPENDENT CLAIM(S) (if applicable)			- \$280.00	\$

TOTAL OF ABOVE CALCULATIONS =

\$

☐ Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above
are reduced by 1/2.

\$

SUBTOTAL =

\$

Processing fee of \$130.00 for furnishing the English translation later than ☐ 20 ☐ 30
months from the earliest claimed priority date (37 CFR 1.492(f)).

\$

TOTAL NATIONAL FEE =

\$

Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be
accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property -

\$

40.00

TOTAL FEES ENCLOSED =

\$

170.00

Amount to be
refunded:

\$

charged:

\$

- a. ☒ A check in the amount of \$ 170.00 to cover the above fees is enclosed. Check No. _____
- b. ☐ Please charge my Deposit Account No. _____ in the amount of \$ _____ to cover the above fees.
A duplicate copy of this sheet is enclosed.
- c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any
overpayment to Deposit Account No. 15-0700. A duplicate copy of this sheet is enclosed.
- d. ☐ Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. Credit card
information should not be included on this form. Provide credit card information and authorization on PTO-2038.

NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR
1.137 (a) or (b)) must be filed and granted to restore the application to pending status.

SEND ALL CORRESPONDENCE TO:

OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, NY 10036-8403

Tel: (212) 382 0700

Edward A. Meilman
SIGNATURE

Edward A. Meilman

NAME

24,735

REGISTRATION NUMBER

The PTO did not receive a check
listed herein

received

UNITED STATES OF AMERICA COMBINED DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION		OFGS FILE NO. P/2107-181																																																								
<p>As a below named inventor, I hereby declare that: my residence, post office address and citizenship are as stated below next to my name; that I verily believe that I am the original, first and sole inventor (if only one name is listed below) or a joint inventor (if plural inventors are named) of the subject matter which is claimed and for which a patent is sought on the invention entitled:</p> <p>CATALYTIC PROCESS FOR THE MODIFICATION OF CARBOHYDRATES, ALCOHOLS, ALDEHYDES OR POLYHYDROXY COMPOUNDS</p> <p>the specification of which is attached hereto, unless the following box is checked: -</p> <p><input checked="" type="checkbox"/> was filed on <u>16 March 2000</u> as United States patent Application Number or PCT International patent application number <u>PCT/EP00/02351</u> and was amended on _____ (if any).</p> <p>I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.</p> <p>I acknowledge the duty to disclose all information known to be material to patentability in accordance with Title 37, Code of Federal Regulations, §1.56.</p> <p>I hereby claim priority benefits under Title 35, United States Code §119 of any foreign application(s) for patent or inventor's certificate or United States provisional application(s) listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:</p> <p>Prior Foreign or Provisional Application(s)</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th style="width: 25%;">COUNTRY</th> <th style="width: 25%;">APPLICATION NUMBER</th> <th style="width: 25%;">DATE OF FILING (day, month, year)</th> <th style="width: 25%;">PRIORITY CLAIMED UNDER 35 U.S.C. 119</th> </tr> </thead> <tbody> <tr> <td>Germany</td> <td>199 11 504.4</td> <td>16 March 1999</td> <td>YES <u>XX</u> NO _____</td> </tr> <tr> <td> </td> <td> </td> <td> </td> <td>YES _____ NO _____</td> </tr> <tr> <td> </td> <td> </td> <td> </td> <td>YES _____ NO _____</td> </tr> </tbody> </table> <p>I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th style="width: 33%;">UNITED STATES APPLICATION NUMBER</th> <th style="width: 33%;">DATE OF FILING (day, month, year)</th> <th style="width: 34%;">STATUS (patented, pending, abandoned)</th> </tr> </thead> <tbody> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> </tbody> </table> <p>I hereby appoint customer no. 2352 OSTROLENK, FABER, GERB & SOFFEN, LLP, and the members of the firm, Samuel H. Weiner - Reg. No. 18,510; Jerome M. Berliner - Reg. No. 18,653; Robert C. Faber - Reg. No. 24,322; Edward A. Meilman - Reg. No. 24,735; Steven I. Weisburd - Reg. No. 27,409; Max Moskowitz - Reg. No. 30,576; Stephen A. Soffen - Reg. No. 31,063; James A. Finder - Reg. No. 30,173; William O. Gray, III - Reg. No. 30,944; Louis C. Dujmich - Reg. No. 30,625; Douglas A. Miro - Reg. No. 31,643, and Michael J. Scheer - Reg. No. 34,425, as attorneys with full power of substitution and revocation to prosecute this application, to transact all business in the Patent & Trademark Office connected therewith and to receive all correspondence.</p> <p>SEND CORRESPONDENCE TO: OSTROLENK, FABER, GERB & SOFFEN, LLP 1180 AVENUE OF THE AMERICAS NEW YORK, NEW YORK 10036-8403 CUSTOMER NO. 2352</p> <p style="text-align: right;">DIRECT TELEPHONE CALLS TO: (212) 382-0700</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 40%;">FULL NAME OF SOLE OR FIRST INVENTOR Emine CAPAN</td> <td style="width: 30%;">INVENTOR'S SIGNATURE <i>Emine Capan</i></td> <td style="width: 30%;">DATE 17.09.01</td> </tr> <tr> <td colspan="2">RESIDENCE (City and either State or Foreign Country) Braunschweig, Germany</td> <td>COUNTRY OF CITIZENSHIP Germany</td> </tr> <tr> <td colspan="3">POST OFFICE ADDRESS Rosenstrasse 10, D-38102 Braunschweig, Germany</td> </tr> <tr> <td>FULL NAME OF SECOND JOINT INVENTOR (IF ANY) Marc Sascha HAHNLEIN</td> <td>INVENTOR'S SIGNATURE <i>Marc Sascha Hahnlein</i></td> <td>DATE 24.09.01</td> </tr> <tr> <td colspan="2">RESIDENCE (City and either State or Foreign Country) Mannheim, Germany</td> <td>COUNTRY OF CITIZENSHIP Germany</td> </tr> <tr> <td colspan="3">POST OFFICE ADDRESS Mosbacher Strasse 160, D-68259 Mannheim, Germany</td> </tr> <tr> <td>FULL NAME OF THIRD JOINT INVENTOR (IF ANY) Ulf PRUSSE</td> <td>INVENTOR'S SIGNATURE <i>Ulf Prusse</i></td> <td>DATE 17.09.01</td> </tr> <tr> <td colspan="2">RESIDENCE (City and either State or Foreign Country) Braunschweig, Germany</td> <td>COUNTRY OF CITIZENSHIP Germany</td> </tr> <tr> <td colspan="3">POST OFFICE ADDRESS Madamenweg 19, D-38118 Braunschweig, Germany</td> </tr> </table>				COUNTRY	APPLICATION NUMBER	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 35 U.S.C. 119	Germany	199 11 504.4	16 March 1999	YES <u>XX</u> NO _____				YES _____ NO _____				YES _____ NO _____	UNITED STATES APPLICATION NUMBER	DATE OF FILING (day, month, year)	STATUS (patented, pending, abandoned)										FULL NAME OF SOLE OR FIRST INVENTOR Emine CAPAN	INVENTOR'S SIGNATURE <i>Emine Capan</i>	DATE 17.09.01	RESIDENCE (City and either State or Foreign Country) Braunschweig, Germany		COUNTRY OF CITIZENSHIP Germany	POST OFFICE ADDRESS Rosenstrasse 10, D-38102 Braunschweig, Germany			FULL NAME OF SECOND JOINT INVENTOR (IF ANY) Marc Sascha HAHNLEIN	INVENTOR'S SIGNATURE <i>Marc Sascha Hahnlein</i>	DATE 24.09.01	RESIDENCE (City and either State or Foreign Country) Mannheim, Germany		COUNTRY OF CITIZENSHIP Germany	POST OFFICE ADDRESS Mosbacher Strasse 160, D-68259 Mannheim, Germany			FULL NAME OF THIRD JOINT INVENTOR (IF ANY) Ulf PRUSSE	INVENTOR'S SIGNATURE <i>Ulf Prusse</i>	DATE 17.09.01	RESIDENCE (City and either State or Foreign Country) Braunschweig, Germany		COUNTRY OF CITIZENSHIP Germany	POST OFFICE ADDRESS Madamenweg 19, D-38118 Braunschweig, Germany		
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PCT INITIAL PROCESSING

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09/936,891

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Washington, D.C. 20231
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